

Appln No. 10/621,052

Amdt date June 9, 2005

Reply to Office action of December 9, 2004

**REMARKS/ARGUMENTS**

**Summary of Office action**

In the recent Office action, the following rejections were made:

- claims 1 and 3 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,603,606 to Headen (the Headen patent);
- claim 2 was rejected under 35 U.S.C. 103(a) as being obvious in light of the combination of the Headen patent and U.S. Patent 3,877,327 to Erm (the Erm patent);
- claims 4 - 9 were rejected under 35 U.S.C. 103(a) as being obvious in light of the combination of U.S. Patent 5,689,076 to Usuda (the Usuda patent) and the Headen patent; and
- claim 10 was objected to as being dependent upon a rejected base claim, but was indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Summary of response to Office action**

In response to the Office action claims 1, 2 and 7 have been amended and claims 8 - 10 have been cancelled.

**Anticipation by the Headen patent**

Claims 1 and 3 were rejected as anticipated by the Headen patent. The Headen patent teaches "a unidirectional drive tool

Appln No. 10/621,052

Amdt date June 9, 2005

Reply to Office action of December 9, 2004

cartridge for use as a torque transmitting device" (Abstract). As noted in the Office action, the Headen patent does not teach the limitations of claim 2. Therefore, in the interest of expediting the prosecution of the application claim 1 has been amended to incorporate the limitations of claim 2.

#### **Obviousness in light of the Headen and Erm patents**

Claim 2 was rejected as obvious in light of the teachings of the Headen and Erm patents. Applicants note that the Manual of Patent Examination Procedure (MPEP) sets out the following requirements for maintaining an obviousness rejection (MPEP § 706.02(j)):

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See **MPEP § 2144 - § 2144.09** for examples of reasoning supporting obviousness rejections.

**Appln No. 10/621,052**

**Amdt date June 9, 2005**

**Reply to Office action of December 9, 2004**

The Office action includes the following statement with respect to the combination of the Headen and Erm patents (Office action, pg. 3):

It would have been obvious to one having ordinary skill in the art to modify Headen's apparatus as taught by Erm to include a second socket opening in the other end of the shaft for the purpose of applying substantially amounts of torque to fastener-heads of more than a single shape and size.

Applicant respectfully submit that the Headen patent teaches away from making the combination identified above. The Headen patent teaches attachment of removable socket members to the tool cartridge (see FIG. 8 and Col 8, Lines 43 - 65). The Headen patent describes the purpose of the removable socket members as follows (Col 8, Lines 62 - 65):

In this manner the cartridge 10 of the present invention can be utilized for a multitude of socket and related tool applications in a manner facilitating rapidity in assembly and disassembly.

The removable socket members enable "applying substantially amounts of torque to fastener-heads of more than a single shape and size." Therefore, Applicant submits that one of ordinary skill in the art would not be motivated to abandon this teaching in favor of the technique taught in the Erm patent without a

**Appln No. 10/621,052**

**Amdt date June 9, 2005**

**Reply to Office action of December 9, 2004**

specific teaching to make this combination. Applicant submits that the lack of such a teaching to combine renders the obviousness rejection unwarranted. Therefore, Applicant further submits that claims 1 - 3 as amended are allowable.

**Obviousness in light of the Headen and Usuda patents**

Claims 4 - 9 were rejected as obvious in light of the combination of the Headen and Usuda patents. The Office action states that (Office action, pg. 3):

It would have been obvious to one having ordinary skill in the art to modify Usuda's drum key as taught by Headen to include a handle connected to the shaft by a unidirectional bearing for the purpose of improving torque application system and for directional torque transmission.

The above statement proposes that one of ordinary skill in the art would have been motivated to modify the drum key described in the Usuda patent to improve the application of torque during the tuning of a drum. Applicant submits that one of ordinary skill in the art would not be motivated to provide "improved" torque without a teaching that the torque obtained using a conventional drum key, such as the drum key shown in the Usuda patent, was somehow limited with respect to the application of tuning drums. Even were one of ordinary skill in the art in possession of such a teaching, Applicant respectfully submits that the teaching of the need to "improve" torque alone

**Appln No. 10/621,052**

**Amdt date June 9, 2005**

**Reply to Office action of December 9, 2004**

is insufficient to direct one of ordinary skill in the art to combine specific teachings from the Headen patent with specific teachings of the Usuda patent. Why, for example, would the same teaching not motivate one of ordinary skill in the art to combine the teachings of the Usuda patent with the teachings of the Erm patent (or any other patent in the prior art for that matter)? Without a suggestion to combine the necessary teachings of the Usuda patent and the Headen patent, one of ordinary skill in the art would not regard the limitations of claim 1 obvious. Consequently, Applicant respectfully submits that the obviousness rejection of claims 4 - 9 was inappropriate and Applicant further submits that claims 4 - 6 are allowable.

#### **Claim 7**

Claim 7 has been amended to include some of the limitations of claim 8 and all of the limitations of claim 10. Claim 10 was indicated to be allowable if rewritten in independent form. Applicant respectfully submits that claim 7 is allowable.

Appln No. 10/621,052

Amdt date June 9, 2005

Reply to Office action of December 9, 2004

**Conclusion**

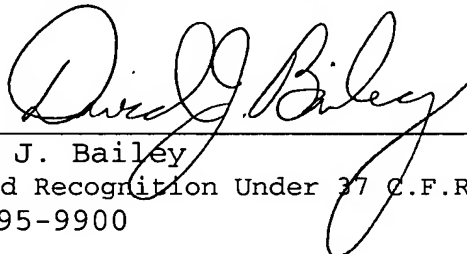
Based upon the discussion provided above, Applicant respectfully submits that claims 1 - 7 are allowable. Therefore, Applicant requests the prompt issuance of a Notice of Allowability.

If Applicant's counsel can be of any assistance with respect to this matter, please do not hesitate to call them at the number listed below.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By

  
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David J. Bailey  
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